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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,631	03/18/2004	Blaine H. Dolph	AUS920040046US1	5810
45371 7590 08/09/2007 IBM CORPORATION (RUS) c/o Rudolf O Siegesmund Gordon & Rees, LLp 2100 Ross Avenue Suite 2600 DALLAS, TX 75201			EXAMINER TEKLE, DANIEL T	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/803,631	Applicant(s) DOLPH, BLAINE H.	
	Examiner Daniel Tekle	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/18/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

Claims 24-26 objected to because of the following informalities: The claims are redundant compare to claims 20-22 respectively. Applicant appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Roth (US 2003/0194199).

**Regarding Claim 1:** Roth discloses a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising: receiving a television program from a service provider (**paragraph 0047**); wherein the television program contains an original marketing (**paragraph 0047**); storing the television program in the memory (**paragraph 0047 and 0048**); sending a user ID and a program ID to the service provider (**paragraph 0046, determining the commercial that specific television sets within its region or governing TV set in the region**); determining whether a local marketing content has been received (**paragraph 0046**); responsive to the

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determination that the local marketing content has been received, creating a modified marketing by modifying the original marketing with the local marketing content **(paragraph 0048)**; and displaying the television program with the modified marketing upon a user request **(paragraph 0048)**.

**Regarding Claim 2:** Roth discloses a method of claim 1 further comprising: determining whether a message indicating that no local marketing content exists for the television program has been received **(paragraph 0046; determining the commercial that specific television sets within the region)**; and responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request **(paragraph 0046)**.

**Regarding Claim 3:** Roth discloses a method of claim 2 further comprising: responsive to the determination that the local marketing content has been received, determining whether the local marketing content is add-on marketing **(paragraph 007 and 0015, local TV station can determine and substitute a local commercial signal in place of a national commercial signal)**; and responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing **(paragraph 007 and 0015, upon determination substitute an alternate commercial signal in place of that replaceable commercial signal)**.

**Regarding Claim 4:** Roth discloses a method of claim 3 further comprising: responsive to the determination that a local marketing content has been received, determining

whether the local marketing content is replacement marketing (**paragraph 0019 and 0022**); and responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing (**paragraph 0022**).

**Regarding Claim 5:** Roth discloses a method of claim 4 further comprising: responsive to the determination that a local marketing content has been received, determining whether the local marketing content is overlay marketing (**paragraph 0022; modified television broadcast signal embedded with additional information**); and responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing (**paragraph 0022; embedding additional information during the planking periods within the first TV signal to generate modified TV signal**).

**Regarding Claim 6:** Roth discloses a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising: receiving a user ID and a program ID (**paragraph 0046**); determining the location of a user based on the user ID (**paragraph 0046**); determining whether a local marketing content exists for a television program based on the program ID (**paragraph 0046**); and responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR (**paragraph 0046**).

**Regarding Claim 7:** Roth discloses a method of claim 6 further comprising: responsive to the determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content (**paragraph 0046**;

**determining the commercial that specific television sets within its region or governing TV set in the region that include either there is a local commercial or not).**

**Regarding Claim 8:** Roth discloses a method of claim 7 wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile **(paragraph 0046).**

**Regarding Claim 9:** Roth discloses a method of claim 8 wherein the local marketing content is add-on marketing **(paragraph 0018).**

**Regarding Claim 10:** Roth discloses a method of claim 8 wherein the local marketing content is replacement marketing **(paragraph 0015).**

**Regarding Claim 11:** Roth discloses a method of claim 8 wherein the local marketing content is overlay marketing **(paragraph 0022).**

**Regarding Claims 12-22:** Claims 12-22 are rejected for the same subject matter as claims 1-11 respectively.

**Regarding Claims 23:** Claims 23 is rejected for the same subject matter as claims 1-11.

**Regarding Claims 24-26:** Claims 24-26 are rejected for the same subject matter as claims 20-22 respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Tekle whose telephone number is 571-270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other F..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel Tekle

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